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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,344	05/11/2001	Gregg Wagner	Color-Spec-App	8684

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EXAMINER
EVANS, FANNIE L

ART UNIT	PAPER NUMBER
2877	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/854,344	Applicant(s) WAGNER ET AL.	
	Examiner F. L. Evans	Art Unit 2877	

-- Th MAILING DATE of this communication appears on the cover she t with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 April 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

The request for a continued prosecution application (CPA) under 37 CFR § 1.53(d) filed on April 10, 2003 is acknowledged. 37 CFR § 1.53(d)(1) was amended to provide that the prior application of a CPA must be: (1) a utility or plant application that was filed under 35 U.S.C. § 111(a) before May 29, 2000, (2) a design application, or (3) the national stage of an international application that was filed under 35 U.S.C. § 363 before May 29, 2000. *See Changes to Application Examination and Provisional Application Practice*, interim rule, 65 *Fed. Reg.* 14865, 14872 (Mar. 20, 2000), 1233 *Off. Gaz. Pat. Office* 47, 52 (Apr. 11, 2000). Since a CPA of this application is not permitted under 37 CFR § 1.53(d)(1), the improper request for a CPA is being treated as a request for continued examination of this application under 37 CFR 1.114. *See id.* at 14866, 1233 *Off. Gaz. Pat. Office* at 48.

A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114. Applicant's submission filed on April 10, 2003 has been entered.

The Affidavit under 37 CFR § 1.132

The affidavit under 37 CFR § 1.132 filed on July 29, 2002 is insufficient to overcome the rejections of claims 1-20 based upon Wagner et al (US 6,157,454) as set forth in the Office action of May 2, 2002 because: The affidavit fails to show that the reference invention is not "by another". The inventive entity (applicant) of the present application is Gregg Wagner, Gary

Emerson and Robert Stewart. The inventive entity (applicant) of U S Patent No. 6,157,454 is Gregg Wagner and Gary Emerson. The affidavit fails show that the subject matter, disclosed but not claimed in U S Patent No. 6,157, 454 was derived from the inventive entity (applicant) of the present application and is not the invention "by another". In fact the affidavit states that any invention disclosed but not claimed in the patent was derived from Gregg Wagner and Gary Emerson. The inventive entity of Gregg Wagner and Gary Emerson is "another".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in-
> (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
> (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR § 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR § 1.131.

Claims 1, 2, 4, 5, 12, 14-16, 19 and 20 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Wagner et al (US 6,157,454), of record.

Wagner et al disclose a handheld, portable color measuring device comprising a color measuring probe housing (2); a hollow probe tip (3) attached to one end of the probe housing; a white light source (lines 11 and 12 in column 8) mounted inside the probe housing and connected to a power source (26); a color measurement switch (5) mounted on the probe housing; means (34,35) for capturing reflected light; a three color sensor (32) mounted in the probe housing; a microprocessor (Fig. 5) mounted in the probe housing; and a display means (4) connected to the microprocessor. Applicant's attention is directed to Wagner et al in its entirety.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. § 102(e), (f) or (g) prior art under 35 U.S.C. § 103(a).

The applied reference (US Patent No. 6,157,454) has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior

art only under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 103(a) might be overcome by: (1) a showing under 37 CFR § 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR § 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. § 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 3, 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (US 6,157,454) in view of Jung et al (US 5,926,262), of record.

Wagner et al disclose essentially every claimed feature except the display means being part of a personal computer connected to the microprocessor.

Jung et al disclose a handheld, portable color measuring device which can be connected to a personal computer. Applicant's attention is directed to Figs. 27 and 28 of Jung et al and the text pertaining thereto in lines 18-38 of column 8, lines 13-19 of column 9, lines 43-67 of column 34 and lines 1-20 of column 35.

At the time the invention was made, it would have been obvious to one of ordinary skill

in the art to connect the color measuring device of Wagner et al to a personal computer and use the display device thereof because such a connection would not have involved an inventive step as evidenced by the disclosure of Jung et al.

Claims 6-8, 10, 11 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (US 6,157,454) in view of Keane et al (WO 96/13709), of record.

Wagner et al disclose essentially every claimed feature except the light pipe for capturing reflected light from the color target.

Keane et al disclose a handheld, portable color measuring device (10) with a light pipe (40) for capturing reflected light from a color target (32). Applicant's attention is directed to lines 8-12 on page 14 of Keane et al.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to use a light pipe to capture reflected light in the color measuring device of Wagner et al because to do so would not have involved an inventive step as evidenced by the disclosure of Keane et al.

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner et al (US 6,157,454) in view of Keane et al (WO 96/13709) as applied to claims 6-8. 10, 11 and 13 above, and further in view of Jung et al (US 5,926,262)

The device proposed above has essentially every claimed feature except the display means being part of a personal computer connected to the microprocessor.

Jung et al disclose a handheld, portable color measuring device which can be connected to a personal computer. Applicant's attention is directed to Figs. 27 and 28 of Jung et al and the text pertaining thereto in lines 18-38 of column 8, lines 13-19 of column 9, lines 43-67 of

column 34 and lines 1-20 of column 35.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to connect the proposed color measuring device to a personal computer and use the display device thereof because such a connection would not have involved an inventive step as evidenced by the disclosure of Jung et al.

Conclusion

This is a RCE of applicant's earlier Application Serial No. 09/854,344. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR § 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Fax/Telephone Numbers

Papers related to this application may be submitted to Technology Center 2800 by

facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax numbers for Technology Center 2800 are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

If applicant wishes to send a fax containing a Proposed Amendment for discussion during either a personal interview or a telephone interview then the fax should:

1) Contain either the statement "**DRAFT**" or "**PROPOSED AMENDMENT**" on the Fax Cover Sheet; and
2) Should be unsigned by the attorney or agent.

This will ensure that the amendment will not be entered into the application and will be forwarded to the examiner as quickly as possible.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to the examiner whose telephone number is (703) 308-4805. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font, can be reached on (703) 308-4881. The TC Receptionist's telephone number is (703) 308-0956.

Any other inquiry of a technical nature, and all inquiries of a general nature including those relating to the status of an application should be directed to TC 2800 Customer Service Office whose telephone number is (703) 306-3329.

F. L EVANS
PRIMARY EXAMINER
ART UNIT 2877

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May 19, 2003